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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD A. MCCOY

Appeal 2015-006599¹
Application 12/256,502²
Technology Center 3600

Before HUBERT C. LORIN, KENNETH G. SCHOPFER, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the rejection of claims 1–10, 12–24, and 26–34. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references the Appeal Brief (“Appeal Br.,” filed Dec. 1, 2014) and Reply Brief (“Reply Br.,” filed June 29, 2015), and the Examiner’s Answer (“Ans.,” mailed Apr. 29, 2015) and Final Office Action (“Final Act.,” mailed June 30, 2014).

² According to Appellant, the real party in interest is Whirlpool Corporation. Appeal Br. 1.

BACKGROUND

According to Appellant, “[t]he invention relates to a method of inventory management using container-based sensors for determining an attribute of a substance and for selectively introducing and activating self-reporting containers for participating in an inventory management system.” Spec. ¶ 1.

CLAIMS

Claims 1–10, 12–24, and 26–34 are on appeal. Claim 1 is the only independent claim on appeal and recites:

1. A method of activating, into an automated inventory system in communication with a data processing system with a memory, a portable self-reporting container containing a consumable substance and having a sensing and reporting system and a memory provided on the container storing a first identifier, the method comprising the steps of:

generating a second identifier at the sensing and reporting system of the container;

transmitting the second identifier from the sensing and reporting system to the data processing system;

adding the second identifier to the memory of the data processing system; and

replacing the first identifier with the second identifier in the memory provided on the container;

wherein the generating the second identifier and replacing the first identifier with the second identifier are triggered by a substance access event at the container.

Appeal Br. 14.

REJECTIONS

1. The Examiner rejects claims 1–10, 12–24, and 26–34³ under 35 U.S.C. § 103(a) as unpatentable over Hart⁴ in view of Carr.⁵
2. The Examiner rejects claims 1–10, 12–24, and 26–34 under 35 U.S.C. § 101 as directed to ineligible subject matter.

DISCUSSION

Obviousness

With respect to claim 1, the Examiner finds that Hart discloses a method as claimed including the steps of generating a second identifier; transmitting the second identifier; and adding the second identifier to the memory of the data processing system. Final Act. 3 (citing Hart Abstract; ¶¶ 7, 16–18, 179). The Examiner acknowledges that Hart does not teach replacing the first identifier with the second identifier, for which the Examiner relies on Carr. Final Act. 3 (citing Carr ¶¶ 1, 10, 16–18). The Examiner concludes it would have been obvious to expand the method of Hart to include replacing the first identifier with the second identifier because it would “provide[] safe pharmaceutical prescription dispensing directly by physicians, pharmacists, and other trained or licensed practitioners operating in small to medium size locations in a cost effective manner.” Final Act. 3–4 (citing Hart ¶ 15).

We are persuaded of error in the rejection because we agree with Appellant that the Examiner has not established that Carr teaches the step of

³ Although the heading for this rejection lists claims 1–33 as rejected, we note that claims 11 and 25 have been cancelled and the body of the rejected addresses claim 34. See Final Act. 3–10.

⁴ Hart et al., US 2003/0216831 A1, pub. Nov. 20, 2003.

⁵ Carr et al., US 2002/0183883 A1, pub. Dec. 5, 2002.

replacing the first identifier with the second identifier. Appeal Br. 9. Carr discloses a product package and method of labeling a product package via an integrated circuit device included on the package. *See* Carr ¶¶ 7, 10. Using this package, Carr discloses “a method of providing enhanced inventory control and dissemination of product information.” *Id.* at ¶ 16. As part of this method, Carr discloses that product information may be written on the package’s integrated circuit or that only a unique identification code may be written on the integrated circuit, which is linked to information about the produce in an electronic database. *Id.* Although Carr appears to contemplate a variety of information written on the package’s integrated circuit or associated with the package’s unique identifier, we see no indication in the cited portions of Carr that any information is used to replace other information, i.e. Carr does not appear to expressly disclose replacing a first identifier with a second identifier.

In response to Appellant’s argument, the Examiner states

that the capability as taught by Hart in view of Carr, to “write information on” an “integrated circuit device” would include the ability to write, and/or replace a “first identifier” with a “second identifier” in the memory that is provided on the container. As such, the Examiner respectfully submits that Hart in view of Carr seemingly suggests, “replacing a first identifier with a second identifier in the memory provided on the container”, as recited by the Appellant.

Ans. 16. However, we agree with Appellant that “[t]he mere capability of a prior art structure to perform a method or a particular step of a method does not, in the absence of other support, [suggest] the method or step.” Reply Br. 6. The Examiner has not provided any adequate explanation as to why one of ordinary skill in the art would have found it obvious to implement the

step of replacing the first identifier with the second identifier in Hart based on the disclosure of Carr.

For these reasons, we are do not sustain the rejection of claim 1 as obvious. We also do not sustain the rejection of the dependent claims, 2–10, 12–24, and 26–34, for the same reasons.

Ineligible Subject Matter

In the Answer, the Examiner enters a new ground of rejection, finding that all of the claims on appeal are directed to ineligible subject matter.

Ans. 10–11. In particular, the Examiner finds that the claims are directed to the abstract concept of comparing new and stored information and using rules to identity options and that the claims do not include any elements that amount to more than the abstract concept “because the computer as recited is a generic computer component that performs functions” and “a first identifier, a second identifier, a self-reporting container, a sensing and reporting system and a data processing system, . . . do not add meaningful limitations to the idea . . . beyond generally linking the system to a particular technological environment, that is, implementation via computers.” *Id.*

As discussed below, we are not persuaded of reversible error by Appellant’s arguments.

Alice Corp. Pty. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101.

According to Alice step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355. Appellant challenges the Examiner’s finding that the claims are directed to the abstract idea of

comparing new and stored information and using rules to identify options, and Appellant argues that the claims are clearly directed to the statutory category of a process. Reply Br. 1–2. More specifically, Appellant argues that claim 1 does not include any limitation related to “the identification of options.” *Id.* at 2. We are not persuaded of error and agree with the Examiner that the claims are directed to an abstract idea. Specifically, we find that the claims are directed to the abstract concept of inventory accounting, i.e. updating inventory information for a particular item, an idea long prevalent in our system of commerce. Taken to a further level of abstraction, we agree this essentially equates to the abstract idea identified by the Examiner, i.e. using rules to replace stored information with new information. Further, the options provided in the context of the claim are whether or not to overwrite the old, stored information.

Step two is “a search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)). Claim 1 generally recites a method of activating, including generating and transmitting a second identifier, adding the second identifier to memory, and replacing a first identifier with the second identifier. These each may be said to relate to generic computer functions. Further, we agree with the Examiner that the addition of a container with a sensing and reporting system does not “amount to significantly more than the judicial exception.” Ans. 10–11. On this point, we are guided by the descriptions of

the technology used to implement the methods as described in the Specification. In particular, the Specification states:

In general, a container 16 may be manufactured and configured with sensing and reporting system 20.

The sensing and reporting system may include analog or digital componentry which is able to determine information about a substance 30 or information associated with a substance like amount, temperature, and the like. In particular, as shown in FIGURES 2 and 2A a sensing and reporting system 20 may include sensing apparatus, such as a sensor 34, and reporting apparatus, such as a transmitter 36.

Spec. ¶¶ 48–49. Further, regarding the sensors and transmitters, the Specification discloses:

A sensor is any active or passive device capable of obtaining information in a form which may be either actively or passively communicated to another device for use by the other device. A communication of information is the delivery of information from a first device to a second device either by the active transmission from the first device to the second device or by the reading of the second device by the first device. A transmitter is any device which wirelessly communicates information to other devices using any form of active or passive transmission including optical or electromagnetic waves.

Id. at ¶ 34. Thus, the Specification indicates that the disclosed methods of the inventory control system, and specifically the sensing and reporting system, use generic sensors and transmitters, i.e. generic computer components to perform their functions. Thus, we are not persuaded that the claims require “a highly specific structure of a portable self-reporting container containing a consumable substance and having a sensing and reporting system and a memory provided on the container.” Reply Br. 2. Adding generic computer parts and functions to a container does not elevate the claims to eligibility. Rather, we find that the steps of the claims, taken

both individually and as an ordered combination, do not transform the nature of the claim into a patent-eligible application. *See Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1259 (Fed. Cir. 2016) (citing *Alice*, 134 S. Ct. at 2358; *Mayo*, 132 S. Ct. at 1294) (“Limiting the field of use of the abstract idea to a particular existing technological environment does not render any claims any less abstract.”)

Finally, Appellant’s preemption argument does not alter our analysis. *See* Reply Br. 2–3. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. *Alice*, 134 S. Ct. at 2354 (‘We have described the concern that drives this exclusionary principle as one of pre-emption[.]’). For this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). Preemption concerns are, thus, fully addressed and rendered moot where a claim is determined to disclose patent ineligible subject matter under the two-part framework described in *Mayo* and *Alice*. Although “preemption may signal patent ineligible matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

For these reasons, we sustain the rejection of claims 1–10, 12–24, and 26–34 as directed to ineligible subject matter.

CONCLUSION

For the reasons set forth above, we conclude as follows:

We REVERSE the rejection of claims 1–10, 12–24, and 26–34 under 35 U.S.C. § 103(a) as unpatentable over Hart in view of Carr.

We AFFIRM the rejection of claims 1–10, 12–24, and 26–34 under 35 U.S.C. § 101 as directed to ineligible subject matter.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED